

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

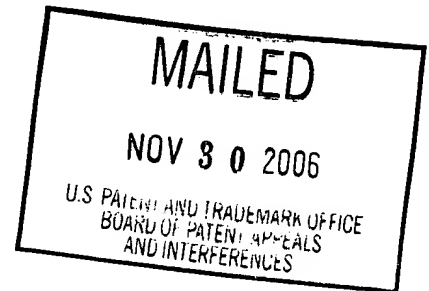
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DALE BURNS and THEODORE PALLES

Appeal No. 2006-3035
Application No. 09/491,919

ON BRIEF



Before HAIRSTON, JERRY SMITH, and MACDONALD, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-4, 6, 7 and 10-13. The examiner has indicated that claims 5, 8, 9, 14 and 15 contain allowable subject matter if rewritten in independent form.

THE INVENTION

The disclosed invention pertains to a system and method for email screening.

Representative claims 1, 6 and 10 are illustrative:

1. An email screening system comprising:
 - a recipient computer connected to a network;
 - an email screening server connected to the recipient computer over the network;
 - a sender computer connected to the recipient computer and the email screening computer over the network;
 - wherein said recipient computer further comprises software instructions for forwarding all email messages received to the email screening server; and
 - wherein the email screening server further comprises software instructions for screening the email for viruses and notifying the sender computer that the email will be forwarded to the recipient computer for a fee.

6. A method for detecting viruses in email and administrating email for a recipient comprising:

- an email screening server connected to a network assigning a password to an email recipient connected to the network;
- software on a recipient computer rerouting email received by the email recipient computer to the email screening server over the network;
- screening the email by the email screening server for viruses;
- forwarding screened email to a recipient computer if the email possess a recipient password; and
- holding email at the email screening server when the email is without the recipient password.

10. A method of virus screening of email comprising:

- a recipient computer re-routing received email from the recipient computer to a screening server over a network;
- the screening server scanning the email for a virus;
- the screening server notifying the sender computer of the email that the scanned email will be sent to the recipient computer for a fee;
- the screening server sending the scanned email to the recipient computer over the network if the fee is paid; and

- sharing the fee with a recipient associated with the recipient computer.

THE REFERENCES

The examiner relies upon the following references:

Hardy et al. (Hardy)	6,073,242	Jun. 6, 2000
	(filed	Mar. 19, 1998)
Council	6,192,114	Feb. 20, 2001
	(filed	Sep. 2, 1998)
Hypponen et al. (Hypponen)	US2003/0191957	Oct. 9, 2003
	(filed	Feb. 19, 1999)

THE REJECTIONS

The following rejections are on appeal before us:

1. Claims 1 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Council in view of Hypponen.
2. Claims 2-4, 6, 7 and 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Council in view of Hypponen, and further in view of Hardy.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii)(2004). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

It is our view, after consideration of the record before us, that the evidence relied upon supports the examiner's rejection of the claims on appeal. Accordingly, we affirm.

GROUPING OF CLAIMS

We consider the obviousness of the following logical groups of claims, as defined under separate subheadings and argued separately by appellants in the briefs.

- GROUP A: Claims 1 and 10 [brief, pages 5-8].
- GROUP B: Claims 2, 4, 6 and 7 [brief, pages 8 and 9].
- GROUP C: Claim 3 [brief, pages 9 and 10].
- GROUP D: Claims 11-13 [brief, page 11].

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be

basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness

is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

GROUP A, claims 1 and 10

As per independent claim 1:

We consider first the examiner's rejection of claim 1 as being obvious over Council in view of Hypponen.

Appellants argue that the examiner's motivational statement lacks any basis or foundation in the prior art and also that the examiner has impermissibly used hindsight in formulating the rejection [reply brief, page 5; brief, page 5]. Appellants argue that neither Council nor Hypponen teaches or suggests forwarding of email by a "recipient computer" for scanning and/or authorization [brief, page 5, ¶2]. Appellants assert that the mail server of Hypponen is not a "recipient computer" because a mail server is not a recipient node, but only a transit node on the way to a recipient [brief, page 5, ¶2]. Appellants further argue that neither Council nor Hypponen teaches or suggests a recipient computer that forwards all email

messages received to an email screening server, as required by the language of claim 1.

The examiner disagrees [answer, page 6]. The examiner asserts that an artisan would have been motivated to employ the teachings of Hypponen (i.e., redirecting received email to a screening server) to Council's recipient computer and screening server in order to allow centralized email screening by forwarding received email to a screening system [answer, page 7]. The examiner further asserts that appellants are reading limitations from the specification into the claims regarding the claimed "recipient computer" [answer, page 7, ¶3]. The examiner asserts that Hypponen teaches a recipient computer comprising software instructions for forwarding email messages received to the email screening server at page 2, ¶¶ 0035-0036 and page 3, ¶¶ 0040 and 0041 [answer, page 8].

In the reply brief, appellants further argue that the examiner's interpretation of the instant claimed "recipient computer" is not a reasonable interpretation consistent with the specification [reply brief, page 5].

At the outset, we do not find appellants' arguments persuasive that the examiner has impermissibly used hindsight in formulating the rejection. We note that the Court of Appeals for the Federal Circuit has determined that the motivation to combine under § 103 must come from a teaching or suggestion within the prior art, within the nature of the problem to be

solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000) [emphasis added]. In the instant case, we note that Hypponen provides evidence that it would have been well within the general knowledge of a person of ordinary skill in the art that unsolicited email frequently arrives with a virus attachment [see ¶¶ 0002-0004]. Therefore, we find the examiner has provided an adequate motivation that reasonably sets forth why an artisan would have been motivated to modify Council's email system with the virus detection system disclosed by Hypponen.

We also find that a broad but reasonable interpretation of the claimed "recipient computer" reads on the Hypponen reference in the manner argued by the examiner. We construe the recited term "recipient computer" in accordance with its plain, ordinary, and accustomed meaning as broadly encompassing any computer that receives data. We note that Hypponen's computer nodes consist of "protected systems" such as: firewall 4a, mail server 4b, proxy server 4c, and database server 4d [¶ 0032]. We also note that Hypponen shows computers 4a, 4b, 4c, and 4d each connected to network 3 [fig. 1].

Furthermore, we find the examiner's interpretation of the claimed "recipient computer" to be entirely consistent with the breadth of support found within the instant specification at page 7, lines 4 and 5: i.e., "Recipient computer 16 is connected to a network, preferably the Internet, although this is not meant as a limitation" [emphasis added].

With respect to appellants' argument that neither Council nor Hypponen teaches or suggests a recipient computer that forwards all email messages, we agree with appellants that Hypponen's system only intercepts and scans certain types of data. We note that Hypponen's system passes over data that is not of a suspect type [¶ 0036]. Therefore, we acknowledge the existence of differences between the prior art and the instant invention.

However, we note that the Supreme Court has found that in making the determination of "obviousness," it is important to remember that the criterion is measured not in terms of what would be obvious to a layman, but rather what would be obvious to one "reasonably skilled in (the applicable) art." Dann v. Johnston, 425 U.S. 219, 229, 189 USPQ 257, 261 (1976), citing Graham v. John Deere Co., 383 U.S. 1, 37, 148 USPQ 459, 474 (1966) [emphasis added].

We note that the Supreme Court in Dann reached a finding of obviousness by concluding that "assuming such an awareness," respondent's system would have been obvious to one "reasonably skilled in (the

applicable) art” even though, as the court explicitly noted, that “[t]here may be differences between respondent's invention and the state of the prior art.” Dann, 425 U.S. 219 at 229, 189 USPQ at 261 [emphasis added]. In particular, we note that the Supreme Court held in Dann that “the mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness ... [where] [t]he gap between the prior art and respondent's system is simply not so great as to render the system nonobvious to one reasonably skilled in the art.” Dann, 425 U.S. 219 at 230, 189 USPQ at 261 [emphasis added].

We further note that the Supreme Court has explicitly recognized that “[b]oth the novelty and the nonobviousness requirements of federal patent law are grounded in the notion that concepts within the public grasp, or those so obvious that they readily could be, are the tools of creation available to all. They provide the baseline of free competition upon which the patent system's incentive to creative effort depends.” Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 156, 9 USPQ2d 1847, 1854 (1989) [emphasis added].

In the instant case, we find the gap between the prior art and the instant claimed invention is simply not so great as to render the system nonobvious to one reasonably skilled in the art. In particular, we find that Hypponen's virus detection and scanning system suggests to

one reasonably skilled in the art the obvious advantage of scanning all data for viruses so as to prevent the spread of viruses over a computer network. Therefore, because the mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness, we will sustain the examiner's rejection of independent claim 1 as being unpatentable over Council in view of Hypponen.

As per independent claim 10:

We consider next the examiner's rejection of independent claim 10 as being obvious over Council in view of Hypponen. We note that appellants essentially restate the same arguments that we have fully addressed supra with respect to independent claim 1. Therefore, we will sustain the examiner's rejection of independent claim 10 as being unpatentable over Council in view of Hypponen for the same reasons discussed supra with respect to independent claim 1.

Group B, claims 2, 4, 6 and 7

We consider next the examiner's rejection of claims 2, 4, 6 and 7 as being unpatentable over the teachings of Council in view of Hypponen, and further in view of Hardy. Since appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall

together, we will consider independent claim 6 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellants argue that there is no motivation to further combine the Hardy reference with the examiner's previous combination of Council and Hypponen [brief, page 9]. Appellants argue that neither Council nor Hypponen suggests any desirability or need for authorization keys and signatures used for encryption and verification, as taught by Hardy [*id.*]. Appellants conclude that the examiner has engaged in impermissible hindsight in formulating the rejection [*id.*].

The examiner disagrees [answer, page 9]. The examiner notes that Hardy is relied upon merely for its teaching of passwords as a means of authorization (col. 9, lines 15-17) [*id.*]. The examiner argues that an artisan would have been motivated to modify the combined teachings of Council and Hypponen with Hardy's authorization passwords to avoid the maintenance requirements associated with Council's authorization list.

Again, we do not find appellants' arguments persuasive that the examiner has impermissibly used hindsight in formulating the rejection. We find that the Hardy reference provides evidence that the advantages of using passwords for authorization purposes were well within the general knowledge of a person of ordinary skill in the art at the time of the invention [col. 9, lines 15-17]. Therefore, we find the examiner has provided an

adequate motivation that reasonably sets forth why an artisan would have been motivated to modify the combined teachings of Council and Hypponen with the authorization passwords disclosed by Hardy. Accordingly, we will sustain the examiner's rejection of representative claim 6 as being unpatentable over Council in view of Hypponen, and further in view of Hardy. We further note that appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 2, 4 and 7. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the examiner's rejection of these claims for the same reasons set forth by the examiner in the rejection.

Group C, claim 3

We consider next the examiner's rejection of dependent claim 3 as being unpatentable over the teachings of Council in view of Hypponen, and further in view of Hardy. We note that claim 3 recites: "wherein the instructions stored by said email screening server further comprise software instructions for holding all email messages without the password."

Appellants argue that holding email is not inherent in not sending it since other options such as deleting or sending to another location exist [brief, page 9, cont'd page 10]. Appellants note that Council informs the sending party at step 23 (fig. 2) and saves the email message at steps 18

and 21 (fig. 2) [brief, page 10]. Appellants assert that Hypponen deals with a different matter of viruses and teaches quarantining data and informing an administrator, which is different than holding an email message [id.]. Appellants assert that the examiner has failed to establish a prima facie case of obviousness with respect to dependent claim 3.

The examiner disagrees [answer, page 10]. The examiner asserts that holding all email messages without a password is included in the Council-Hypponen system, since if the sending party is not authorized to send email to the recipient then the sending party is asked to pay a fee for delivery of the email message to the recipient (see Council, col. 1, lines 28-33 and col. 2, lines 33-44) [id.]. The examiner notes that Council further teaches storing the email message when the sender's address is not in the list of authorized senders (col. 2, lines 33-44) [id.].

After carefully reviewing all the evidence before us, we will sustain the examiner's rejection of dependent claim 3 for essentially the same reasons argued by the examiner in the answer. We note that the instant specification discloses that email messages that arrive with a system password are forwarded directly to the recipient [page 6, lines 12 and 13]. In contrast, email messages arriving without a system password are screened and delivered to the recipient only if the sender agrees to pay a fee [instant specification, page 6, lines 16 and 17]. We find that this operation

is directly analogous to the operation of the combined Council-Hypponen system, as argued by the examiner. Instead of a password system, the Council-Hypponen system relies upon an authorization list, as discussed supra. The examiner relies upon Hardy for the use of authorization passwords [Hardy, col. 9, lines 15-17]. We also note that the examiner has not asserted inherency in the rejection [see answer, pages 4, 5 and 10]. The examiner has merely asserted that holding all email messages without a password is included in the combined Council-Hypponen system [answer, pages 4 and 10]. We find that the language of claim 3 does not preclude the holding of email contingent upon payment of a fee by the sender, as taught by the combined Council-Hypponen system [see Council, col. 2, lines 2-7]. We further find that it would have been obvious for an artisan to substitute Hardy's password system in place of Council's authorization list, as discussed supra. We acknowledge that Council discloses discarding email if the sending party is not on an authorization list and has not authorized fees to be charged [col. 2, lines 2-7; see also reply brief, page 6, ¶13]. However, we find the gap between the prior art and the instant claimed invention is simply not so great as to render the system nonobvious to one reasonably skilled in the art. See Dann, 425 U.S. 219 at 230, 189 USPQ at 261. Therefore, we find that the evidence relied upon and the level of skill in the art would have suggested to an artisan the obviousness of the invention set

forth in claim 3. Accordingly, we agree with the examiner that the subject matter of claim 3 is unpatentable over Council in view of Hypponen, and further in view of Hardy.

Group D, claims 11-13

Lastly, we consider next the examiner's rejection of dependent claims 11-13 as being unpatentable over the teachings of Council in view of Hypponen, and further in view of Hardy. Since appellant's arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider dependent claim 11 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellants essentially restate previous arguments regarding the examiner's reading of the claimed "recipient computer" on the cited references and the examiner's alleged use of impermissible hindsight in formulating the rejection [brief, page 11].

We note that we have fully addressed these points of argument with respect to claims 1 and 10, as discussed supra. Because we find appellants arguments unpersuasive, we will sustain the examiner's rejection of claims 11-13 as being unpatentable over Council in view of Hypponen, and further

in view of Hardy, for essentially the same reasons argued by the examiner in the answer [see answer, pages 10-12].

In summary, we have sustained the examiner’s rejections of all claims on appeal. Therefore, the decision of the examiner rejecting claims 1-4, 6, 7 and 10-13 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED.


Kenneth W. Hairston
Administrative Patent Judge


Jerry Smith
Administrative Patent Judge


Allen R. MacDonald
Administrative Patent Judge

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